

REMARKS

Summary of the Amendment

Upon entry of the above amendment, claims 16-18 will have been canceled and claims 11, 15 and 32-34 will have been amended. Accordingly, claims 11-15 and 19-34 will be pending, with claims 11, 33 and 24 being in independent form.

Summary of the Official Action

In the Office action, the Examiner indicated that claims 22 and 23 were withdrawn as being directed to a non-elected invention and indicated that the restriction requirement was made final. The Examiner also objected to the drawings. Next, the Examiner objected to the Amendment filed on May 23, 2002 as introducing new matter. The Examiner also rejected claims 12 and 13 under section 112, first paragraph, as failing to comply with the written description requirement. Additionally, the Examiner rejected claims 1-34 under section 112, second paragraph, as being indefinite. Finally, the Examiner rejected claims 11-21 and 24-34 over the applied art of record. By the present amendment and remarks, Applicant submits that the objections and rejections have been overcome, and respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

The Finality of the Instant Rejection is improper

Applicant notes that the Examiner indicated on the form PTOL-326 that the instant Office Action is a Final Office Action. However, on page 8 of the instant Office Action, the Examiner specifically indicated that “[t]his is a non-final action”. Accordingly, Applicant respectfully submits that the designation of finality of the instant Office Action is improper and respectfully requests clarification thereof.

Present Amendment is proper for entry

Applicant submits that the instant amendment is proper for entry after final rejection (assuming that the Examiner intended to render the instant Office Action final), at least because the Examiner indicated on page 8 of the instant Office Action that “[t]his is a non-final action” and/or because the Examiner agreed in the Interview of March 22, 2004 that the response would be considered. Moreover, Applicant notes that no question of new matter nor are any new issues raised in entering the instant amendment of the claims and that no new search would be required, especially since the Examiner has fully considered the features recited in the claims.

Moreover, Applicant submits that the instant amendment places the application in condition for allowance, or at least in better form for appeal.

Accordingly, Applicant request that the Examiner enter the instant amendment,

consider the merits of the same, and indicate the allowability of the present application and each of the pending claims.

Interview of March 22, 2004

Applicant appreciates the courtesy extended by Examiner Merek in the Interview of March 22, 2004. In that interview, Applicant's representative discussed, among other things, that:

the restriction was improper on the basis of a species election because a National stage application can only be subject to a restriction requirement under the unity of invention standard by evaluating independent claims. It was specifically noted that dependent claims cannot properly be restricted from independent claims under the unity of invention standard since such claims share at least all of the features of the independent claims. Applicant also pointed out that Applicant was entitled to have the withdrawn dependent claims rejoined if and when the independent claims, from which they depend, become allowed. The Examiner agreed to review Applicant's arguments in this regard;

the objection to the drawings as not showing two bars secured to the flap was entirely improper because Figs. 1, 2 and 5 clearly show bars 6 and 7 secured to the flap 5. Moreover, page 3, lines 5-6 of the original specification, as well as original claim 3, clearly explains that the bars 6 and 7 can be fixed to the flap 5. The Examiner agreed to review Applicant's

arguments in this regard;

the objection to the Amendment filed on May 23, 2002 was improper because the amendment introduced language which was fully supported by the original disclosure and did not introduce new matter. Specifically, it was pointed out that original claim 4 provides clear and full support for the feature “foldable tongues fixed to the flap or to the journal system of the rigid bars”. It was also pointed out that original claim 1 provides clear and full support for the feature “the flexible container may be adapted to be opened and closed often”. Finally, it was pointed out that the original claims form part of the original disclosure and that MPEP 608.04 clearly explains that “[i]n establishing a disclosure, applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it” (Emphasis added). The Examiner agreed to review Applicant’s arguments in this regard;

the rejection of claims 12 and 13 under section 112, first paragraph, as failing to comply with the written description requirement was improper because original claim 1 and page 1, lines 5-8 of the original specification provides clear and full support for storing a valuable in a nautical environment. Moreover, original claim 1 also provides full and clear support for opening and closing the container often. Thus, it was argued, claims 12 and 13 do not introduce new matter. The Examiner agreed to review Applicant’s arguments in this regard;

the rejection of claims 1-34 under section 112, second paragraph, as being indefinite with regard to the use of the term “type” in claims 11, 33 and 34 was improper because one of ordinary skill in the art would understand the meaning of this term. Moreover, Applicant also agreed to remove this term from claims 11, 33 and 34 in an effort to advance prosecution. Applicant also pointed out that the specification clearly explains how the bars are movably mounted. Specifically, it was pointed out that page 3, lines 5-10 of the original specification, as well as Figs. 1-3 and 5, make clear how the bars 6 and 7 are movably mounted and that one of ordinary skill in the art would recognize how the bars 6 and 7 move with the flap 5. The Examiner agreed to review Applicant’s arguments in this regard;

the prior art documents fail to teach each of the two rigid bars being fixed to a flap at different locations, wherein the two rigid bars are arranged opposite one another when the system for locking the two rigid bars together engages the two rigid bars at both ends of the rigid bars. The Examiner agreed to reconsider the prior art rejections if claims 11, 33 and 34 were amended to recite these features.

The Election/Restriction is improper

The Examiner indicated that claims 22 and 23 were withdrawn as being directed to a non-elected invention.

Applicant respectfully submits that the withdrawal of claims 22 and 23 was improper

and contrary to current USPTO rules. Applicant reiterates the arguments presented in the “Election With Traverse” file in the instant application on August 15, 2003.

Specifically, Applicant submits that the restriction is improper because a species election in a National stage application can only be subject to a restriction requirement under the unity of invention standard by evaluating the independent claims. Dependent claims cannot properly be restricted from independent claims under the unity of invention standard since such claims share at least all of the features of the independent claims.

Applicant further submits that it is entitled to have the withdrawn dependent claims rejoined if and when independent claim 11, from which they depend, becomes allowed.

Traversal of the objection to the drawings

The Examiner objected to the drawings on the basis that they do not show two bars secured to the flap. Applicant respectfully disagrees.

Figs. 1-3 and 5 clearly show bars 6 and 7 secured to the flap 5. Moreover, page 3, lines 5-6 of the original specification, as well as original claim 3, clearly explains that the bars 6 and 7 can be fixed to the flap 5.

Accordingly, the objection is believed to be rendered moot and/or is traversed and the Examiner is requested to withdraw this objection.

Traversal of the objection to the Amendment filed May 23, 2002

The Examiner objected to the Amendment filed May 23, 2002 on the basis that it introduces new matter. Applicant respectfully disagrees.

While the Examiner has concluded that certain language which was introduced into the specification contains new matter, Applicant submits that, contrary to the Examiner's assertions, each feature recited in amendment to the specification finds full and clear support in the original disclosure.

Applicant notes original claim 4 provides clear and full support for the feature "foldable tongues fixed to the flap or to the journal system of the rigid bars". Moreover, original claim 1 provides clear and full support for the feature "the flexible container may be adapted to be opened and closed often".

Applicant reminds the Examiner that the original claims form part of the original disclosure. Indeed, MPEP 608.04 clearly explains that "[i]n establishing a disclosure, applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it" (Emphasis added).

Applicant further notes that MPEP 2163.06 specifically indicates that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter." Moreover, MPEP 2163.01 also specifically explains that "subject matter of the claim need not be

described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.”

Finally, to the extent that the Examiner believes that some terms are not literally used in the original disclosure, Appellant reminds the Examiner that “the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” See *All Dental Prodx, LLC v. Advantage Dental Products, Inc.*, 02-1107 (Fed. Cir. 2002) noting *Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995). A copy of the *All Dental Prodx* case is attached to the instant Amendment.

Accordingly, the objection is believed to be rendered moot and/or is traversed and the Examiner is requested to withdraw this objection.

Traversal of the Section 112, first paragraph, rejection

The Examiner rejected claims 12 and 13 on the basis of section 112, first paragraph, as failing to comply with the written description requirement because claims 12 and 13 were asserted as introducing new matter. Applicant respectfully disagrees.

As a preliminary matter, Applicant assumes that claim 11 (which is mentioned in the rejection) is not rejected on this basis because the Examiner has pointed to no informality in

claim 11 and has not specifically designated claim 11 as being rejected.

Moreover, while the Examiner has concluded that the language of claims 12 and 13 introduces new matter, Applicant submits that each feature recited in these claims finds full and clear support in the original disclosure, i.e., in the original drawings, specification and claims.

Applicant notes original claim 1 and page 1, lines 5-8 of the original specification provides clear and full support for storing a valuable in a nautical environment. Moreover, original claim 1 also provides full and clear support for opening and closing the container often.

Applicant also submits that the Examiner has clearly failed to evaluate the claims on the correct standard for measuring compliance with the written description requirement. The standard is not one requiring express support in the original disclosure (which Applicant believes in this case is fully met by the recited language). To the contrary, MPEP 2163.05 indicates that the correct standard for measuring claims under the written description requirement is one wherein “each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure” (emphasis added). Applicant submits that the originally filed disclosure (including the drawings and claims) provide clear implicit and/or inherent support for these claims.

As explained above, MPEP 2163.06 specifically indicates that “information contained

in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.” Moreover, MPEP 2163.01 specifically explains that “subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.”

Finally, Applicant again reminds the Examiner that “the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” See *All Dental Prodx, LLC v. Advantage Dental Products, Inc.*, 02-1107 (Fed. Cir. 2002) noting *Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995). A copy of the *All Dental Prodx* case is attached to the instant Amendment.

Accordingly, the rejection is believed to be rendered moot and/or is traversed and the Examiner is requested to withdraw this objection.

The Indefiniteness Rejection, is moot and/or traversed

Claims 1-34 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite on the basis of various asserted informalities.

While Applicant disagrees that the use of the term “type” in claims 11, 33 and 34

renders the claims indefinite, Applicant has, by this Amendment, amended these claims to remove this term.

Applicant also disagrees with the Examiner's assertion that "it is not clear how the bars are movably mounted". Applicant notes that page 3, lines 5-10 of the original specification and Figs. 1-3 and 5 make clear how the bars 6 and 7 are movably mounted. Applicant further submits that one of ordinary skill in the art, having read the disclosure, would recognize how the bars 6 and 7 move and/or are movably mounted, e.g., one or more of the bars can clearly move with the flap 5.

Applicant also disagrees that it is inconsistent to recite that the bars are both movable and secured to a flap. The bars 6 and 7 are clearly described as being fixed to the flap 5 and the flap is clearly described and/or shown as being movable. There is no inconsistency between these features.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 112, second paragraph.

Traversal of Rejections Under 35 U.S.C. § 102

Over NEVES

Applicant respectfully traverses the rejection of claims 11-15, 19, 24-31 and 33 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,837,918 NEVES et al.

The Examiner asserted that this document discloses all the features recited in these claims including a container with movable bars. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what this document discloses, Applicant submits that NEVES fails to disclose, or even suggest, inter alia, a flexible container with a sealable closure system comprising two rigid bars being configured to tightly engage edges of the opening in order to seal the enclosure closed, *each of the two rigid bars being fixed to a flap at different locations*, at least one of the two rigid bars being movable, and a system for locking the two rigid bars together, wherein the system for locking the two rigid bars together engages the two rigid bars at both ends of the two rigid bars, and *wherein the two rigid bars are arranged opposite one another when the system for locking the two rigid bars together engages the two rigid bars at both ends of the rigid bars*, as recited in amended independent claim 11, and inter alia, a flexible container with a sealable closure system comprising two rigid bars being configured to tightly engage edges of the opening in order to seal the enclosure closed, *each of the two rigid bars being fixed to a flap at different locations*, one of the two rigid bars being positioned against one of the impermeable walls when the enclosure is closed, another of the two rigid bars being positioned against another of the impermeable walls when the enclosure is closed, and a system for locking the two rigid bars together, wherein the system for locking the two rigid bars together engages the two

rigid bars, and *wherein the two rigid bars are arranged opposite one another when the system for locking the two rigid bars together engages the two rigid bars at both ends of the two rigid bars*, as recited in amended independent claim 33.

Applicant acknowledges that NEVES discloses a waterproof pocket with bars 16 and 17. However, it is clear from a fair reading of the figures of this document that the pocket does not utilize a flap. Accordingly, it follows that such a document cannot disclose that *each of the two rigid bars is fixed to a flap at different locations*.

Thus, Applicant submits that the above-noted claims are not disclosed, or even suggested, by any proper reading of NEVES.

Applicant further notes that, for an anticipation rejection under 35 U.S.C. § 102 to be proper, each element of the claim in question must be disclosed in a single document, and if the document relied upon does not do so, then the rejection must be withdrawn.

Because NEVES fails to disclose at least the above mentioned features as recited in independent claims 11 and 33, Applicant submits that this document does not disclose all the claimed features recited in at least independent claims 11 and 33.

Furthermore, Applicant submits that dependent claims 12-15, 19 and 24-31 are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper reading of NEVES discloses or suggests, in

combination: that the flexible container is adapted to store valuables in a nautical environment as recited in claim 12; that the flexible container is adapted to be opened and closed often as recited in claim 13; that the two rigid bars are arranged parallel to one another as recited in claim 14; that each of the two rigid bars are movably mounted to the flap and are each configured to be correctly positioned adjacent an edge of the enclosure before tightening as recited in claim 15; that the system for locking the two rigid bars together comprises at least one of locking elements and foldable tongues as recited in claim 19; that the flexible container further comprises a compressible member arranged on an inner surface of at least one of the edges of the opening as recited in claim 24; that the flexible container further comprises a compressible member arranged on an inner surface of each of the edges of the opening as recited in claim 25; that each compressible member is attached to an edge by one of gluing and fixing as recited in claim 26; that the compressible members are configured to movably engage each other when the enclosure is opened and closed as recited in claim 27; that the compressible members are arranged opposite one another as recited in claim 28; that the edges are configured to be stiffened by strips made of a metal or a synthetic material as recited in claim 29; that the flexible container is adapted to at least one of trap air or gas and to float as recited in claim 30; and that the impermeable walls are deformable as recited in claim 31.

Applicant requests that the Examiner reconsider and withdraw the rejection of the

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above-noted claims under 35 U.S.C. § 102(b).

Over WESOLOWSKI

Applicant respectfully traverses the rejection of claims 11-13, 15-18, 29-31, 33 and 34 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,093,345 to WESOLOWSKI.

The Examiner asserted that this document discloses all the features recited in these claims including a container with a flap and movable bars. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what this document discloses, Applicant submits that WESOLOWSKI fails to disclose, or even suggest, inter alia, a flexible container with a sealable closure system comprising two rigid bars being configured to tightly engage edges of the opening in order to seal the enclosure closed, *each of the two rigid bars being fixed to a flap at different locations*, at least one of the two rigid bars being movable, and a system for locking the two rigid bars together, wherein the system for locking the two rigid bars together engages the two rigid bars at both ends of the two rigid bars, and *wherein the two rigid bars are arranged opposite one another when the system for locking the two rigid bars together engages the two rigid bars at both ends of the rigid bars*, as recited in amended independent claim 11, inter alia, a flexible container with a sealable closure system

comprising two rigid bars being configured to tightly engage edges of the opening in order to seal the enclosure closed, *each of the two rigid bars being fixed to a flap at different locations*, one of the two rigid bars being positioned against one of the impermeable walls when the enclosure is closed, another of the two rigid bars being positioned against another of the impermeable walls when the enclosure is closed, and a system for locking the two rigid bars together, wherein the system for locking the two rigid bars together engages the two rigid bars, and *wherein the two rigid bars are arranged opposite one another when the system for locking the two rigid bars together engages the two rigid bars at both ends of the two rigid bars*, as recited in amended independent claim 33, and inter alia a flexible container with a sealable closure system comprising two rigid bars being configured to tightly engage edges of the opening in order to seal the enclosure closed, *each of the two rigid bars being fixed to the movable flap at different locations*, one of the two rigid bars being positioned against one of the impermeable walls when the enclosure is closed, another of the two rigid bars being positioned against another of the impermeable walls when the enclosure is closed, and a system for locking the two rigid bars together, wherein the system for locking the two rigid bars together engages the two rigid bars, and *wherein the two rigid bars are arranged opposite one another when the system for locking the two rigid bars together engages the two rigid bars at both ends of the two rigid bars*, as recited in amended independent claim 34.

Applicant acknowledges that WESOLOWSKI discloses a waterproof pouch with bars

13 and 15 and a flap 10. However, it is clear from a fair reading of this document that there is no disclosure with regard to *each of the two rigid bars being fixed to a flap at different locations*. To the contrary, the only keeper 15 can arguably be said to be fixed to the flap 10. Indeed, Fig. 3 clearly shows that the pin 13 is movably fixed to the keeper 15 (via a joint 14) and is not fixed to the flap 10.

Thus, Applicant submits that the above-noted claims are not disclosed, or even suggested, by any proper reading of WESOLOWSKI.

Applicant further notes that, for an anticipation rejection under 35 U.S.C. § 102 to be proper, each element of the claim in question must be disclosed in a single document, and if the document relied upon does not do so, then the rejection must be withdrawn.

Because WESOLOWSKI fails to disclose at least the above mentioned features as recited in independent claims 11, 33 and 34, Applicant submits that this document does not disclose all the claimed features recited in at least independent claims 11, 33 and 34.

Furthermore, Applicant submits that the rejection of claims 16-18 is moot inasmuch as these claims have been canceled. Additionally, Applicant submits that dependent claims 12, 13, 15 and 29-31 are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper reading of WESOLOWSKI discloses or suggests, in combination: that the flexible container is adapted

to store valuables in a nautical environment as recited in claim 12; that the flexible container is adapted to be opened and closed often as recited in claim 13; that the two rigid bars are arranged parallel to one another as recited in claim 14; that each of the two rigid bars are movably mounted to the flap and are each configured to be correctly positioned adjacent an edge of the enclosure before tightening as recited in claim 15; that the edges are configured to be stiffened by strips made of a metal or a synthetic material as recited in claim 29; that the flexible container is adapted to at least one of trap air or gas and to float as recited in claim 30; and that the impermeable walls are deformable as recited in claim 31.

Applicant requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 102(b).

Over STRAYER

Applicant respectfully traverses the rejection of claims 11-15 and 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,820,582 to STRAYER.

The Examiner asserted that this document discloses all the features recited in these claims. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what this document discloses, Applicant submits that STRAYER fails to disclose, or even suggest, inter alia, a flexible container with a sealable closure system comprising two rigid bars being configured to tightly

engage edges of the opening in order to seal the enclosure closed, *each of the two rigid bars being fixed to a flap at different locations*, at least one of the two rigid bars being movable, and a system for locking the two rigid bars together, wherein the system for locking the two rigid bars together engages the two rigid bars at both ends of the two rigid bars, and *wherein the two rigid bars are arranged opposite one another when the system for locking the two rigid bars together engages the two rigid bars at both ends of the rigid bars*, as recited in amended independent claim 11.

Applicant acknowledges that STRAYER discloses a waterproof receptacle with bars 14 and a flap 19. However, it is clear from a fair reading of this document that there is no disclosure with regard to *each of the two rigid bars being fixed to a flap at different locations*. To the contrary, Fig. 6 clearly shows that the flap 19 merely covers the bars 14. Nor do the figures even show any contact between the bars 14 and the flap 19.

Thus, Applicant submits that the above-noted claims are not disclosed, or even suggested, by any proper reading of STRAYER.

Applicant further notes that, for an anticipation rejection under 35 U.S.C. § 102 to be proper, each element of the claim in question must be disclosed in a single document, and if the document relied upon does not do so, then the rejection must be withdrawn.

Because STRAYER fails to disclose at least the above mentioned features as recited in independent claim 11, Applicant submits that this document does not disclose all the

claimed features recited in at least independent claim 11.

Furthermore, Applicant submits that dependent claims 12-15 and 21 are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper reading of WESOLOWSKI discloses or suggests, in combination: that the flexible container is adapted to store valuables in a nautical environment as recited in claim 12; that the flexible container is adapted to be opened and closed often as recited in claim 13; that each of the two rigid bars are movably mounted to the flap and are each configured to be correctly positioned adjacent an edge of the enclosure before tightening as recited in claim 15; and that the system for locking the two rigid bars together comprises locking members, each locking member having an opening that is sized to confine one end of each of the two rigid bars as recited in claim 21.

Applicant requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 102(b).

Traversal of Rejections Under 35 U.S.C. § 103(a)

Over Neves with Iosif and Strayer

Applicant respectfully traverses the rejection of claim 20 under 35 U.S.C. § 103(a) as unpatentable over NEVES in view of US Patent 5,428,871 to IOSIF and further in view of

STRAYER.

The Examiner acknowledged that NEVES lacks the recited foldable tongues and the recited locking members. However, the Examiner asserted that IOSIF teaches a foldable tongue and that it would have been obvious to modify the device of NEVES in view of the teachings of IOSIF. The Examiner also asserted that STRAYER teaches the locking members and that it would have been obvious to modify the device of NEVES in view of the teachings of STRAYER. Applicant respectfully traverses this rejection and each of the Examiner's assertions.

Notwithstanding the Office Action assertions as to what these documents disclose or suggest, Applicant submits that no proper combination of the above-noted documents discloses or suggests, inter alia, a flexible container with a sealable closure system comprising two rigid bars being configured to tightly engage edges of the opening in order to seal the enclosure closed, *each of the two rigid bars being fixed to a flap at different locations*, at least one of the two rigid bars being movable, and a system for locking the two rigid bars together, wherein the system for locking the two rigid bars together engages the two rigid bars at both ends of the two rigid bars, and *wherein the two rigid bars are arranged opposite one another when the system for locking the two rigid bars together engages the two rigid bars at both ends of the rigid bars*, as recited in amended independent claim 11.

As explained above, NEVES lacks any disclosure or suggestion with regard to a flap,

much less, that *each of the two rigid bars being fixed to a flap at different locations*.

Moreover, while it is apparent that STRAYER discloses a waterproof receptacle with bars 14 and a flap 19, it is also clear from a fair reading of this document that there is disclosure or suggestion with regard to *each of the two rigid bars being fixed to a flap at different locations*. To the contrary, Fig. 6 clearly shows that the flap 19 merely covers the bars 14. Nor do the figures even show any contact between the bars 14 and the flap 19.

Finally, while Applicant notes that IOSIF apparently discloses a bag clamp with two bars 12 and 14, it is also clear from a fair reading of this document that there is disclosure or suggestion with regard to *each of the two rigid bars being fixed to a flap at different locations*. To the contrary, IOSIF merely discloses a clamp for clamping side walls of a bag.

Thus, Applicant submits that the above-noted document fails to disclose or suggest the features recited in at least independent claim 11. Because none of NEVES, IOSIF and STRAYER discloses or suggests at least the above-noted features of the instant invention, Applicant submits that no proper combination or modification of these documents can render unpatentable the combination of features recited in at least independent claim 11.

Furthermore, Applicant submits that there is no motivation or rationale disclosed or suggested in the art to modify any of the applied documents in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner.

Therefore, Applicant submits that the invention as recited in at least independent claim 11 is not rendered obvious by any reasonable inspection of these disclosures.

Furthermore, Applicant submits that dependent claim 20 is allowable at least for the reason that this claim depends from allowable base claim and because this claim recites additional features that further define the present invention. In particular, Applicant submits that no proper combination of NEVES, IOSIF and STRAYER discloses or suggests, in combination: that the system for locking the two rigid bars together comprises foldable tongues, each foldable tongue having an opening that is sized to confine one end of each of the two rigid bars as recited in claim 20.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the above-noted rejection under 35 U.S.C. § 103(a) and indicate that this claim is allowable over the applied art of record.

Over Neves with Paull

Applicant respectfully traverses the rejection of claim 26 under 35 U.S.C. § 103(a) as unpatentable over NEVES in view of US Patent 1,792,117 to PAULL.

The Examiner acknowledged that NEVES fails to teach gluing the bars. However, the Examiner asserted that PAULL teaches a securing such devices with cement and that it would have been obvious to modify the device of NEVES in view of the teachings of

PAULL. Applicant respectfully traverses this rejection and each of the Examiner's assertions.

Notwithstanding the Office Action assertions as to what these documents disclose or suggest, Applicant submits that no proper combination of the above-noted documents discloses or suggests, inter alia, a flexible container with a sealable closure system comprising two rigid bars being configured to tightly engage edges of the opening in order to seal the enclosure closed, *each of the two rigid bars being fixed to a flap at different locations*, at least one of the two rigid bars being movable, and a system for locking the two rigid bars together, wherein the system for locking the two rigid bars together engages the two rigid bars at both ends of the two rigid bars, and *wherein the two rigid bars are arranged opposite one another when the system for locking the two rigid bars together engages the two rigid bars at both ends of the rigid bars*, as recited in amended independent claim 11.

As explained above, NEVES lacks any disclosure or suggestion with regard to a flap, much less, that *each of the two rigid bars being fixed to a flap at different locations*.

Moreover, while Applicant notes that PAULL apparently discloses a device 17 with two bars for clamping an opening of a pocket, it is also clear from a fair reading of the figures that this document does not disclose or suggest a flap, much less, that *each of the two rigid bars being fixed to a flap at different locations*.

Thus, Applicant submits that the above-noted documents fail to disclose or suggest

the features recited in at least independent claim 11. Because neither NEVES nor PAULL discloses or suggests at least the above-noted features of the instant invention, Applicant submits that no proper combination or modification of these documents can render unpatentable the combination of features recited in at least independent claim 11.

Furthermore, Applicant submits that there is no motivation or rationale disclosed or suggested in the art to modify any of the applied documents in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claim 11 is not rendered obvious by any reasonable inspection of these disclosures.

Furthermore, Applicant submits that dependent claim 26 is allowable at least for the reason that this claim depends from allowable base claim and because this claim recites additional features that further define the present invention. In particular, Applicant submits that no proper combination of NEVES and PAULL discloses or suggests, in combination: that each compressible member is attached to an edge by one of gluing and fixing as recited in claim 26.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the above-noted rejection under 35 U.S.C. § 103(a) and indicate that this claim is allowable over the applied art of record.

Over Wesolowski with Nelson

Applicant respectfully traverses the rejection of claim 32 under 35 U.S.C. § 103(a) as unpatentable over WESOLOWSKI in view of NELSON.

The Examiner acknowledged that WESOLOWSKI fails to teach a flap securing mechanism. However, the Examiner asserted that NELSON teaches this feature and that it would have been obvious to modify the device of WESOLOWSKI in view of the teachings of NELSON. Applicant respectfully traverses this rejection and each of the Examiner's assertions.

Notwithstanding the Office Action assertions as to what these documents disclose or suggest, Applicant submits that no proper combination of the above-noted documents discloses or suggests, inter alia, a flexible container with a sealable closure system comprising two rigid bars being configured to tightly engage edges of the opening in order to seal the enclosure closed, *each of the two rigid bars being fixed to a flap at different locations*, at least one of the two rigid bars being movable, and a system for locking the two rigid bars together, wherein the system for locking the two rigid bars together engages the two rigid bars at both ends of the two rigid bars, and *wherein the two rigid bars are arranged opposite one another when the system for locking the two rigid bars together engages the two rigid bars at both ends of the rigid bars*, as recited in amended independent claim 11.

As explained above, WESOLOWSKI fails to disclose or suggest that *each of the two*

rigid bars is fixed to a flap at different locations. To the contrary, the only keeper 15 can arguably be said to be fixed to the flap 10. Indeed, Fig. 3 clearly shows that the pin 13 is movably fixed to the keeper 15 (via a joint 14) and is not fixed to the flap 10.

Moreover, while Applicant notes that NELSON apparently discloses a waterproof pocket with a flap 15, it is also clear from a fair reading of the figures that this document does not disclose or suggest two bars, much less, that *each of the two rigid bars is fixed to a flap at different locations.*

Thus, Applicant submits that the above-noted document fails to disclose or suggest the features recited in at least independent claim 11. Because no proper combination of WESOLOWSKI and NELSON discloses or suggests at least the above-noted features of the instant invention, Applicant submits that no proper combination or modification of these documents can render unpatentable the combination of features recited in at least independent claim 11.

Furthermore, Applicant submits that there is no motivation or rationale disclosed or suggested in the art to modify any of the applied documents in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claim 11 is not rendered obvious by any reasonable inspection of these disclosures.

Furthermore, Applicant submits that dependent claim 32 is allowable at least for the reason that this claim depends from allowable base claim and because this claim recites additional features that further define the present invention. In particular, Applicant submits that no proper combination of WESOLOWSKI and NELSON discloses or suggests, in combination: that the flexible container further comprises a mechanism for releasably securing the flap on one of the impermeable walls as recited in claim 32.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the above-noted rejection under 35 U.S.C. § 103(a) and indicate that this claim is allowable over the applied art of record.

CONCLUSION

Applicant respectfully submits that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 112, 102 and 103 and respectfully requests the Examiner to indicate allowance of each and every pending claim of the present invention.

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious Applicant's invention, as recited in each of the pending claims. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention

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have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

The Commissioner is hereby authorized to charge any fees necessary for consideration of this amendment to deposit account No. 19-0089.

Should there be any questions, the Examiner is invited to contact the undersigned attorney at the number listed below.

Respectfully submitted,
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United States Court of Appeals for the Federal Circuit

02-1107

ALL DENTAL PRODX, LLC and
DMG DENTAL-MATERIAL GESELLSCHAFT MBH,

Plaintiffs-Appellees,

v.

ADVANTAGE DENTAL PRODUCTS, INC.,

Defendant-Appellant.

Jeffrey M. Butler, Kenyon & Kenyon, of New York, New York, argued for plaintiffs-appellees. With him on the brief were Richard L. Mayer, and Jeffrey S. Ginsberg.

Douglas W. Sprinkle, Gifford, Krass, Groh, Sprinkle, Anderson & Citkowski, P.C., of Birmingham, Michigan, argued for defendant-appellant.

Appealed from: United States District Court for the Eastern District of New York

Senior Judge Jacob Mishler

United States Court of Appeals for the Federal Circuit

02-1107

ALL DENTAL PRODX, LLC and DMG DENTAL-MATERIAL GESELLSCHAFT MBH,

Plaintiffs-Appellees,

v.

ADVANTAGE DENTAL PRODUCTS, INC,

Defendant-Appellant.

DECIDED: October 25, 2002

Before NEWMAN, Circuit Judge, FRIEDMAN, Senior Circuit Judge, and LOURIE, Circuit Judge.

LOURIE, Circuit Judge.

Advantage Dental Products, Inc. appeals from the decision of the United States District Court for the Eastern District of New York granting the declaratory judgment plaintiffs All Dental Prodx, LLC and DMG Dental-Material Gesellschaft mbH (collectively, "All Dental") summary judgment that Advantage Dental's U.S. Patent 5,213,498 is invalid and not infringed by All Dental. All Dental Prodx, LLC v. Advantage Dental Prods., Inc., CV-00-2393,-5785 (E.D.N.Y. Aug. 7, 2001). Because the '498 patent has not been shown to be invalid, we reverse that portion of the judgment. Because there are no genuine issues of material fact that All Dental does not infringe the patent, we affirm that portion of the judgment. Accordingly, we affirm-in-part and reverse-in-part.

BACKGROUND

Advantage owns the '498 patent, which is directed to a method for making a custom dental impression tray. Dentists typically form an impression of a patient's tooth or teeth as part of the process for constructing a crown, cap, or other dental appliance. '498 patent, col. 1, ll. 14-16. The '498 patent describes the prior art impression process as utilizing a suitably sized tray filled with alginet and then placing the tray over the tooth or teeth of which an impression is desired; as the alginet sets, it forms an impression of the area of interest. Id. at ll. 19-26. The invention of the '498 patent improves this process by utilizing less expensive materials and reducing the patient's "chair time." Id. at ll. 31-49. The '498 patent discloses that polycaprolactone, after being heated to the point of pliability (approximately 140°F), can be comfortably molded directly over a person's teeth, without the need for a tray or container. Id. at col. 2, ll. 36-43. After cooling to body temperature, the polycaprolactone mold is rigid, thus forming an impression. Id.

The patent contains two claims, both of which are independent method claims reciting, inter alia, the following step:

- (1) heating an original unidentified mass of thermosetting^{*} material to a predetermined temperature range at which the thermosetting material becomes pliable, . . .

Id. at col. 4, ll. 46-49, 58-61 (emphasis added). The specification does not define the phrase “original unidentified mass,” which was introduced into the claims during prosecution. In the first Office Action, the claims were rejected as unpatentable under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,227,877, issued to Tureaud et al., which discloses an acrylic thermoplastic material shaped anatomically in the form of a dental impression tray that can be directly molded within a person’s mouth. In response to the rejection, the applicant remarked that Tureaud “does not teach or disclose providing the thermosetting material in an original unidentified mass.” Not persuaded, the Examiner again rejected the claims on the same ground, explaining that the “claims do not recite the material in an ‘original unidentified mass’, rather, they simply recite a material.” The applicant later amended the claims to recite that phrase. The Examiner then withdrew the rejection based on Tureaud and rejected the claims as being anticipated by U.S. Patent 4,413,979, issued to Ginsburg et al., which discloses a sheet of moldable thermoplastic material having two ridges to facilitate folding of the sheet into a U-shape to encompass a quadrant of a person’s teeth. The applicant traversed the Ginsburg rejection, explaining that the claimed invention “teaches away from applying the thermosetting material in any specific form, such as the preformed sheets disclosed by Ginsburg.” The Examiner then allowed the claims and the patent thereafter issued.

All Dental sells a TEMP TABS TRUE BLUE product, which is a flat, oval-shaped polycaprolactone tablet. The tablet is heated until pliable and then molded over a person’s tooth where it cools and hardens, thereby making a dental impression. All Dental brought suit seeking a declaratory judgment that the ’498 patent was invalid and not infringed by its tablet. The court construed the phrase “original unidentified mass” to mean “a mass that does not have specific preformed size and shape.” All Dental Prodx, slip op. at 11. The court granted All Dental summary judgment of noninfringement apparently because the All Dental tablets have a specific preformed shape and size. Id. The court also held both claims of the patent invalid under § 112, ¶¶ 1 and 2. Id. Finding no definition of the phrase “original unidentified mass” in either the patent specification or the prosecution history, the court concluded that “a person skilled in the art would not be able to understand the bounds of the claims.” Id. The court also concluded that the patent “lacks a written description of the invention.” Id.

Advantage Dental appeals from the district court’s grant of summary judgment. We

have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

We review a district court's grant of summary judgment de novo, reapplying the same standard used by the district court. Ethicon Endo-Surgery, Inc. v. United States Surgical Corp., 149 F.3d 1309, 1315, 47 USPQ2d 1272, 1275 (Fed. Cir. 1998). Summary judgment is appropriate "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). "The evidence of the nonmovant is to be believed, and all justifiable inferences are to be drawn in his favor." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255 (1986).

A determination of patent infringement requires a two-step analysis. "First, the court determines the scope and meaning of the patent claims asserted . . . [Second,] the properly construed claims are compared to the allegedly infringing device." Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1454, 46 USPQ2d 1169, 1172 (Fed. Cir. 1998) (en banc) (citations omitted). Step one, claim construction, is an issue of law, Markman v. Westview Instruments, Inc., 52 F.3d 967, 970-71, 34 USPQ2d 1321, 1322 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370 (1996), that we review de novo, Cybor, 138 F.3d at 1456, 46 USPQ2d at 1172. Step two, comparison of the claim to the accused device, requires a determination that every claim limitation or its equivalent be found in the accused device. Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 29 (1997). Those determinations are questions of fact. Bai v. L & L Wings, Inc., 160 F.3d 1350, 1353, 48 USPQ2d 1674, 1676 (Fed. Cir. 1998).

The question whether the subject matter of a patent claim fails to meet the written description requirement of 35 U.S.C. § 112, ¶ 1 is a question of fact. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). A determination that a patent claim is invalid for failure to meet the definiteness requirement of 35 U.S.C. § 112, ¶ 2 is "a legal conclusion that is drawn from the court's performance of its duty as the construer of patent claims[, and] therefore, like claim construction, is a question of law that we review de novo." Atmel Corp. v. Info. Storage Devices, Inc., 198 F.3d 1374, 1378, 53 USPQ2d 1225, 1227 (Fed. Cir. 1999) (citing Personalized Media Communications, LLC v. Int'l Trade Comm'n, 161 F.3d 696, 705, 48 USPQ2d 1880, 1888 (Fed. Cir. 1998)).

Advantage argues that the district court improperly concluded that the '498 patent fails to satisfy both paragraphs of 35 U.S.C. § 112, without providing reasoning for those conclusions. As to the adequacy of the written description, Advantage contends that, while the phrase "original unidentified mass" does not literally appear in the specification, one skilled in the art would recognize and know how to practice the claimed invention using "an original unidentified mass" upon reading the specification. As to definiteness, Advantage contends that, while the meaning of the phrase "original unidentified mass" is neither facially apparent nor defined in the patent specification, the prosecution history clarifies the phrase to mean any shape different from a complete impression tray. On the issue of infringement, Advantage argues, based upon its proposed construction of the phrase "original unidentified mass," that All Dental infringes the patent because its tablets are clearly not in the form of a dental impression tray.

All Dental responds that the "original unidentified mass" language does not appear anywhere in the originally filed patent application, and that it was new matter added during prosecution, arguably in violation of the statute. While acknowledging that the specification need not provide in haec verba support for the language added to the claim, All Dental argues that the originally filed disclosure did not allow one skilled in the art to immediately discern that an "original unidentified mass" limitation was part of the definition of the invention. All Dental also contends that the applicant did not properly act as his own lexicographer in defining the meaning of the phrase "original unidentified mass," as he failed to clearly define the phrase. All Dental further contends that if the phrase "original unidentified mass" is to have any meaning at all, then it must be that the material lacks a specific preformed shape and size, as the district court concluded. All Dental asserts that its accused tablets do not infringe the '498 patent because they clearly have a preformed shape, viz., a generally flat, oblong shape.

We agree with Advantage that there are no genuine issues of material fact concerning whether its patent claims comply with the written description requirement of section 112, first paragraph. While the contested language is not a model of clarity, it is also fairly simple and intelligible, capable of being understood in the context of the patent specification. It is thus reasonably clear what the invention is and that the patent specification conveys that meaning.

Section 112, first paragraph, states, inter alia: "The specification shall contain a written

description of the invention.” 35 U.S.C. § 112, ¶ 1 (2000). In order to comply with the written description requirement, the specification “need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed.” Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (citing Vas-Cath, 935 F.2d at 1562, 19 USPQ2d at 1115, and In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976)).

The application for the '498 patent as originally filed did not contain the phrase “original unidentified mass”; indeed, there is no mention of the starting material’s shape or form anywhere in the patent specification. However, the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented. See Eiselstein, 52 F.3d at 1039, 34 USPQ2d at 1470. Here, the invention involves heating a mass of thermoplastic material that lacks an identifiable form. That invention is described in the specification, albeit not in haec verba. It is also clear what the invention is not. It does not involve heating a thermoplastic mass having an identifiable form or shape. We therefore conclude that there are no genuine issues of material fact that the specification describes the claimed invention within the meaning of the statute. Thus, summary judgment of invalidity for failure to satisfy the written description requirement was erroneous and is therefore reversed.

We also agree with Advantage that its claims comply with the definiteness requirement of section 112, second paragraph. That section states: “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe. Warner-Jenkinson, 520 U.S. at 28-29. That determination requires a construction of the claims according to the familiar canons of claim construction. Only after a thorough attempt to understand the meaning of a claim has failed to resolve material ambiguities can one conclude

that the claim is invalid for indefiniteness. Foremost among the tools of claim construction is of course the claim language itself, but other portions of the intrinsic evidence are clearly relevant, including the patent specification and prosecution history. See Standard Oil Co. v. Am. Cyanamid Co., 774 F.2d 448, 452, 227 USPQ 293, 296 (Fed. Cir. 1985) (“The specification is, thus, the primary basis for construing the claims. . . . [T]he prosecution history (or file wrapper) limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance.”). The prosecution history can thus be relied upon to clarify the claim meaning and hence provide definiteness. Tex. Instruments Inc. v. Int’l Trade Comm’n, 871 F.2d 1054, 1063, 10 USPQ2d 1257, 1263-64 (Fed. Cir. 1989) (“The public is entitled to know the scope of the claims but must look to both the patent specification and the prosecution history, especially when there is doubt concerning the scope of the claims.” (citing McGill Inc. v. John Zink Co., 736 F.2d 666, 221 USPQ 944 (Fed. Cir. 1984))).

In this case, the prosecution history aids in clarifying the meaning of the claim phrase “original unidentified mass.” The patent applicant twice distinguished his invention over the prior art on the basis of that limitation. First, the applicant distinguished his invention over Tureaud’s anatomically formed tray shape as not being an “original unidentified mass.” Secondly, the applicant distinguished his invention over Ginsburg’s preformed sheets of thermoplastic material as “teach[ing] away from applying the thermosetting material in any specific form.” Each of those statements made during prosecution disclaims a specific shape. Moreover, the second statement amounts to a characterization of the “original unidentified mass” limitation as not embracing “any specific form.” Advantage’s argument that the phrase “original unidentified mass” means any shape other than a complete dental tray gives effect to only the first prosecution statement while ignoring the second. Giving proper effect to both statements and the specification’s clear indication of the nature of the invention, we conclude that the phrase means exactly what the district court said it means: “a mass that does not have a specific preformed size and shape.” All Dental Prodx, slip op. at 11. Where we differ from the district court is on whether the phrase as so construed is indefinite. The meaning of the phrase “original unidentified mass,” arrived at after reviewing the specification and consulting the prosecution history, is indeed definite and clear. Thus, the district court

construed the phrase correctly, yet erred in concluding that the phrase was indefinite.

Finally, we agree with All Dental that it is entitled to summary judgment of noninfringement. Our conclusion follows from the construction of the phrase “original unidentified mass.” All Dental’s tablets clearly have a preformed shape; it is uncontested that they are flat, oblong-shaped tablets. Advantage’s infringement assertions therefore fail to raise any genuine issues of material fact, and the court’s grant of summary judgment of noninfringement is affirmed.

CONCLUSION

The district court erred in granting summary judgment that the ’498 patent claims fail to satisfy the requirements of 35 U.S.C. § 112, and we reverse that decision. However, the court correctly granted summary judgment that Advantage’s accused product does not infringe the patent, and we affirm that decision. Accordingly, we

AFFIRM-IN-PART and REVERSE-IN-PART.

COSTS

Costs to All Dental.

* At oral argument, counsel for Advantage conceded that the term “thermosetting” should have been “thermoplastic” in order to correctly describe a material that becomes pliable on heating. We will therefore use the term “thermoplastic” further in this opinion.